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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: May 8, 2006

Opposition No. 91161817

Nextel Communications, Inc.

v.

Motorola, Inc.

Before Quinn, Hohein and Rogers, Administrative Trademark
Judges.

By the Board:

Applicant, Motorola, Inc., (hereinafter "applicant")
has filed an application to register a sound mark which it
describes as "an electronic chirp consisting of a tone at
911 Hz played at a cadence of 25 ms ON, 25 ms OFF, 25 ms ON,
25 ms OFF, 50 ms ON" (hereinafter "911 Hz tone") for "two-
way radios" in International Class 9.¹

As grounds for opposition, Nextel Communications, Inc.,
(hereinafter "opposer") has alleged that applicant, "in
derogation of Sections 1, 2 and 45" of the Trademark Act,
"has not used the 911 Hz tone in commerce in connection with
the goods" and that the mark "is not inherently distinctive
and has not acquired distinctiveness."

¹ Application Serial No. 78235618, filed April 9, 2003, on the
Principal Register based on use in commerce and claiming a date
of first use anywhere and in commerce of May 6, 1991.

Applicant has filed an answer denying the salient allegations of the notice of opposition and alleging the affirmative defenses of acquiescence and laches, but it has since withdrawn those defenses.²

This case now comes up on the parties' cross motions for summary judgment, both filed November 11, 2005.³

Preliminarily, our review of the pleadings in connection with the motions for summary judgment reveals that with regard to the notice of opposition, opposer's pleading of its basis for standing is vague and conclusory. In particular, the notice of opposition contains nonspecific allegations regarding opposer's real interest in this proceeding which, in our view, if proven, would be inadequate to establish opposer's standing.⁴ With regard

² Applicant withdrew its pleaded affirmative defenses in its filing of December 19, 2005.

³ Opposer's motion was electronically filed on November 11, 2005, via the Board's ESTTA filing system; applicant's motion was filed by mail and accompanied by a certificate of mailing dated November 11, 2005.

⁴ Among other things, opposer alleges that applicant and opposer have a long-standing business relationship in which applicant manufactures phones and accessories for opposer; that applicant also manufactures phones and accessories for opposer's direct competitors; and that inasmuch as opposer "is a purchaser and potential purchaser of communications devices incorporating two-way radio capabilities from Applicant and other vendors of such devices, and ... Opposer also sells such devices to end users, it will be damaged by the unjustified registration by Applicant of the 911 Hz tone as set forth in the 911 Hz Tone Application." Such allegations, however, fall short of sufficiently pleading a real interest in the proceeding because there is no allegation of competitive need or direct commercial interest or the like. Thus, any reasonable belief in damage as presently alleged is based upon some vague and unspecified impact that will result from registration of the 911 Hz tone.

to opposer's ground for opposition, opposer has clarified in its summary judgment filings that its claim is based on the involved sound mark's being "consistently and exclusively used in its function as an operational alert signal in a way that would not be perceived by consumers as a source indicating mark." Therefore, we view opposer's basis for the opposition as simply a claim under Sections 1, 2 and 45 of the Trademark Act that, due to the inherent nature or the manner in which applicant's 911 Hz tone is used, the 911 Hz tone does not function as a mark to identify and distinguish applicant's goods and it has neither inherent distinctiveness nor acquired distinctiveness. See TMEP §1202.

With regard to applicant's answer, we note that applicant has not alleged the affirmative defense of acquired distinctiveness, yet applicant has alternatively argued in its opposition to opposer's motion for summary judgment and in support of its motion for summary judgment that, if the 911 Hz tone is not inherently distinctive, it has acquired distinctiveness and is entitled to registration under Section 2(f). To assert such a defense, it must be pleaded. See *Colonial Arms Corp. v. Trulock Firearms Inc.* 5 USPQ2d 1678, 1680 n.5 (TTAB 1987).⁵

⁵ Although acquired distinctiveness presently is not pleaded, we will consider the affirmative defense for purposes of the

We turn now to the parties' cross-motions for summary judgment. With the exception of applicant's argument that summary judgment is appropriate because opposer's discovery responses establish that opposer will be unable to meet its burden at trial, the parties' arguments in support of and in opposition to the cross-motions are essentially the same.⁶

In essence, opposer argues that when consumers hear the 911 Hz tone they perceive the tone as an indicator of the current status of the two-way radio and not as an indicator of the source of the goods; and that because the 911 Hz tone is not a "trademark" within the meaning of the Trademark Act, the 911 Hz tone can neither be inherently distinctive nor acquire distinctiveness. Applicant, on the other hand, argues that the 911 Hz tone is a "dual purpose trademark" having both an operational purpose of alerting users that a communication channel is available while simultaneously

parties' motions for summary judgment because both parties have addressed the defense in their motions.

⁶ Applicant has misconstrued the holding in *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), in attempting to obtain summary judgment based on its argument that opposer cannot meet its burden of proof at trial due to alleged insufficiencies in opposer's discovery responses. To carry its burden as movant on its motion for summary judgment, applicant must show, in essence, that there is no genuine issue of fact about opposer's inability to carry its burden on the Section 1, 2 and 45 claim in this case, not that there is no genuine issue of fact that opposer did not produce evidence during discovery in support of its Section 1, 2 and 45 claim. Moreover, as a matter of law, opposer is not required to meet its burden of proof on its Section 1, 2 and 45 claim at this juncture but, rather, must do so at trial. Applicant, if it believes it has not obtained sufficient or proper discovery responses, does not have a remedy in a motion for summary judgment. Instead, it must file a motion to compel.

serving as a trademark; that applicant's mark is registrable because it is inherently distinctive in that it is "unique," "different" and "distinctive"; and that, alternatively, the 911 Hz tone has acquired distinctiveness as evidenced by, among other things, applicant's survey which shows that consumers recognize the 911 Hz tone as a source indicator.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). The mere fact that cross-motions for summary judgment have been filed does not necessarily mean that there are no genuine issues of material fact, and that trial is unnecessary. See *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389-1390 (TTAB 1994).

We have carefully considered the arguments and evidence presented by each party with respect to the other's motion. We find that neither party has met its burden of establishing that there are no genuine issues of material fact and that it is entitled to summary judgment as a matter of law. At a minimum, there are genuine issues of material

fact regarding whether the 911 Hz tone is a unique or unusual sound emanating from a two-way radio or a mere refinement of a commonplace sound that emanates from a two-way radio; and whether the 911 Hz tone has acquired distinctiveness in view of opposer's challenge to the validity and methodology of applicant's consumer survey evidence as well as its challenge to the sufficiency of applicant's promotional and advertising evidence including the absence of "look for," or perhaps more appropriately, "listen for" advertising.⁷

In view thereof, opposer's motion for summary judgment is denied, and applicant's cross-motion for summary judgment is denied.

As noted above, opposer's pleading of standing is deficient and applicant has not pleaded the affirmative defense of acquired distinctiveness which it raised in briefing the motions for summary judgment. In view thereof, opposer is allowed until THIRTY DAYS from the mailing date of this order in which to file and serve an amended notice of opposition that sufficiently alleges standing. Applicant

⁷ In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). The fact that we have identified only certain genuine issues of material fact as sufficient bases for denying the cross-motions for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

is allowed until FIFTY DAYS from the mailing date of this order to file and serve an amended answer which should include a pleading of the affirmative defense of acquired distinctiveness if applicant intends to rely on this defense at trial.

Proceedings are resumed.

Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **CLOSED**

30-day testimony period for party in position of plaintiff to close: **August 25, 2006**

30-day testimony period for party in position of defendant to close: **October 24, 2006**

15-day rebuttal testimony period for party in position of plaintiff to close: **December 8, 2006**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.